

Appl. No. 10/690,905
Amdt. dated March 23, 2005
Reply to Office action of December 23, 2004

REMARKS/ARGUMENTS

Applicants have received the Office action dated December 23, 2004, in which the Examiner: 1) rejected claims 1-13, 15-23 and 25-26 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Pat. No. 6,665,765 (Tang et al.); 2) rejected claims 14, 16 and 25-26 under 35 U.S.C. § 112, 2nd paragraph, as being indefinite; 3) rejected claims 17 and 22 under 35 U.S.C. § 102(a) as being anticipated by Verdun et al. (U.S. Pat. No. 6,493,782); 4) rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Klein (U.S. Pat. No. 6,035,354) and Verdun; 5) rejected claims 5-7 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Klein, Verdun and Stufflebeam (U.S. Pat. No. 6,460,106); 6) rejected claims 8-15 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Klein, Hennessy et al. (U.S. Pat. No. 6,195,718) and Verdun; 7) rejected claims 18-19 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Verdun and Hennessy; 8) rejected claims 23-26 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Verdun and Klein; and 9) objected to claims 16 and 20-21 as being dependent upon a rejected base claim, but would be allowable if rewritten.

With this Response, Applicants have amended claims 1, 14, 17 and 22 and canceled claims 8-10, 16, 18, 20-21 and 23-26 (note that claims 8, 16, 18, 20 and 21 had been canceled during the Preliminary Amendment that was filed October 22, 2003).

I. DOUBLE PATENTING REJECTION OF CLAIMS 1-13, 15-23 AND 25-26

A terminal disclaimer is enclosed with this response. The terminal disclaimer is believed to overcome the noted obviousness-type double patenting rejection.

II. OBJECTION OF CLAIMS 16 AND 20-21

Note that claims 16 and 20-21 which were objected to as depending on a rejected base claim in this Office action, had been canceled in the Preliminary Amendment dated October 22, 2003, since they are now the claims in issued

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U.S. Patent No. 6,665,765. It also should be noted that claims 8 and 18 were canceled via the noted Preliminary Amendment.

III. REJECTION OF CLAIMS 14 AND 25-26 UNDER U.S.C. § 112, 2ND PARAGRAPH

Claims 14 and 25-26 have been amended in view of the rejection under 35 U.S.C. § 112, 2nd paragraph, and as amended are believed to be in condition to overcome the noted rejection.

IV. REJECTION OF CLAIMS 1-4 UNDER 35 U.S.C. § 103(A)

Claims were rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Klein and Verdun. Independent claim 1 has been amended to recite "the port replicator provides a port replicator attached input signal to the control logic via the drive wedge and said control logic detects a transition in the port replicator detection input signal level when the port replicator is docked to or undocked from the drive wedge." In accordance with claim 1, and as shown in FIG. 1, the port replicator 82 provides its port replicator attached (PRATTACHED#) signal via the drive wedge 72 in order to inform the portable computer 20 that the port replicator has been coupled to the drive wedge.

The cited Klein and Verdun references taken individually or combined fail to teach or suggest a structure as now claimed in claim 1. The Klien and Verdun references fail to teach or suggest how to handle the coupling of a drive wedge and a port replicator that are combined as claimed. Both the Klien and Verdun references teach the coupling of a docking unit without more. No mention on how multiple devices such as the drive wedge 72 and port replicator 82 could be handled is suggested in these references. Furthermore as previously mentioned in the Preliminary Amendment dated October 22, 2003, on page 9, the Hennessy and Stufflebeam references can not be used as prior art given that Hennessy and Stufflebeam and the present application are commonly owned as discussed in detail in the Preliminary Amendment. At least for these reasons it is believed that claim 1 is now in condition for allowance and along with dependent claims 2-4.

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V. REJECTION OF CLAIMS 5-7 UNDER 35 U.S.C. § 103(A)

Claims 5-7 depend on amended claim 1 and in view of the above arguments for independent claim 1 are also believed to be in condition for allowance. As previously mentioned, the cited Stufflebeam reference can not be used as prior art given the common ownership of the reference and the present application as discussed previously.

VI. REJECTION OF CLAIMS 8-15 UNDER 35 U.S.C. § 103(A)

Claims 8-10 are currently canceled. Dependent claim 11 and 12 add further nonobvious claim limitations to independent claim 1 and are therefore believed to be in condition for allowance in view of the above noted arguments. Claim 13-15 are also believed to be in condition for allowance given the arguments previously made including that the cited Hennessy reference can not be used as a prior art reference against the present application. As such claim 11-15 are believed to be in condition for allowance.

VII. REJECTION OF CLAIMS 17 AND 22 UNDER 35 U.S.C. § 102(A)

Claim 17 has been amended in part to recite "the computer includes a configurable digital portion of a network interface and the port replicator includes an analog portion of the network interface and further comprising: masking a configuration select input signal to said digital portion to prevent the digital portion from responding to a configuration request when the port replicator is not coupled to the computer." None of the cited reference teach or suggest such a claim limitation, as such, independent claim 17 is believed to be in condition for allowance. Dependent claim 19 which depends on claim 17 is also believed to be in condition for allowance.

Independent claim 22 has been amended to now recite in part "a configurable portion of a network interface; a port replicator including a second portion of the network interface; and a means for masking a configuration select signal to the configurable portion of the network interface to prevent the configurable portion of the network interface from responding to a configuration request when the port replicator is not coupled to the portable computer." Neither the cited Verдум nor any of the other cited reference teach or suggest such a

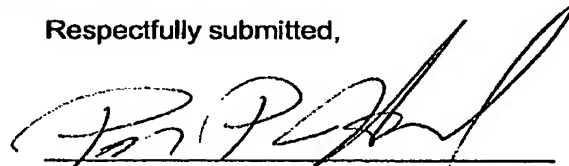
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structure and as such, claim 22 is believed to be in condition for allowance. Dependent claims 23-26 have been canceled in order to expedite prosecution of the present application.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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